

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1634
	)	
PEDERSEN, et al.	)	Examiner: WHISENANT, E.
	)	
Serial No.: 10/507,121	)	Washington, D.C.
	)	
Filed: March 17, 2005	)	October 20, 2008
	)	
Patent No.: 7,413,854	)	
	)	
Issued: August 19, 2008	)	
	)	
For: METHOD FOR SYNTHESISING	)	Docket No.: PEDERSEN=9
TEMPLATED MOLECULES	)	
	)	Confirmation No.: 8893

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

S i r :

Pursuant to 37 CFR 1.705(d), reconsideration of the patent term adjustment (237 days) indicated on the face of the above-identified patent is hereby requested. The patent should have indicated a revised patent term to take into account the period of adjustment required by 1.704(b), which became known only once the patent issued.

In accordance with 37 CFR 1.705(b)1), submitted herewith is the fee of \$200 as set forth in 37 CFR 1.18(e). If there is any underpayment or any other fee necessary for consideration of this request, please charge same to the deposit account no. 02-4035 of the undersigned.

The following statement of the facts involved is in compliance with 37 CFR 1.705(b)(2).

1. The correct patent term adjustment is 392 days.
2. The filing date was March 17, 2005, so 14 months later was May 17, 2006. The period of delay under 37 CFR 1.703(a)(1) is 267 days, as properly calculated by the PTO (the period of time from May 17, 2006 to February 8, 2007, when the first office

action under 35 USC 132 was mailed).

3. There are no adjustments under 1.703(a)(2)-(6).

4. However, the PTO failed to take into account the non-overlapping period of delay under 37 CFR 1.703(b). The period of time from March 17, 2008 (three years after the 371(c) date) to the issuance of the patent on August 19, 2008, was 155 days.

5. There is no overlap within the meaning of 1.703(f), as interpreted by the U.S. District Court in *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. September 30, 2008) between the "A" period ending February 8, 2007 and the "B" period beginning March 17, 2008.

6. The patent is not subject to a terminal disclaimer.

7. The PTO correctly calculated the period attributable to applicant's delay as 30 days.

8. The correct patent term adjustment is the sum of the A period (267 days) and B period (155 days), minus any period attributed to applicant's delay (37 CFR 1.704). Thus, the patent term adjustment should be  $267+155-30=392$  days.

9. This request is timely under 1.704(d). These issues could not have been raised on or before the date of payment of the issue fee (June 19, 2008) as the period under 1.704(b) did not become determined until the patent issued.

Moreover, Applicants could reasonably have relied, at the time the issue fee was paid, on the PTO's interpretation of the "overlap" provision as set forth in "Explanation of 37 CFR 1.703(f) and the United States Patent and Trademark Office Interpretation of 35 USC 154(b)(2)(A)", 69 Fed. Reg. 34238, as quoted in *Wyeth v. Dudas*. However, the U.S. District Court in the *Wyeth* case, *supra*, decided on September 30, 2008, ruled that the PTO procedures in this regard were not in accordance with a correct interpretation of the statute. Thus, only since September 30, 2008, has it been known for certain that the PTO's method of calculation under 1.703(f) were incorrect. Accordingly, this request for reconsideration of the patent term adjustment must be permitted under 37 CFR 1.705(d).

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Granting of this request and modifying the patent term adjustment afforded this case to a total of 392 days are therefore earnestly solicited.

Respectfully submitted,

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